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13 Jan 2004
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ATTORNEY DOCKET NO. 057309-5002-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : David M. Long *et al.*

U.S. Application No.: 10/018,691 ✓

International Appln. Filing Date: July 2, 1999

Group Art Unit: Unassigned

Date of National Stage Entry: December 20, 2001

Examiner: Unassigned

For: TAXOL PRODUCTION VIA GENERATION OF
EXTRACHROMOSOMAL DNAs IN THE FUNGUS
PESTALOTIOPSIS

MAIL STOP PCT

**RENEWED PETITION FOR FILING AN APPLICATION UNDER 37 C.F.R. §1.47(a)
and 37 C.F.R. § 1.137(b) with accompanying STATEMENT OF FACTS IN SUPPORT
THEREOF**

Sir:

This Renewed Petition is being submitted in response to the Decision on Petition Under 37 C.F.R. § 1.47(a) and 37 CFR 1.137(b) ("Decision") mailed August 19, 2003, which dismissed the petition. The Decision cited two reasons for dismissing the petition: 1) because a properly executed declaration had not been submitted by the petitioner; and 2) because it was not clear if the petitioner had submitted a Sequence Listing as requested.

As a initial matter, we note that Decision was not received by petitioner until January 6, 2004, after petitioner inquired about the status of the case via telephone and the Office of PCT Legal Administration faxed a copy of the Decision to petitioner. Petitioners did not timely receive the Decision because it was sent to the following (old) incorrect address:

Morgan Lewis & Bockius LLP
1800 M Street, N.W.
Washington, D.C. 20036

However, the following is the petitioner's correct address:

Morgan Lewis & Bockius LLP
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004

U.S. Patent Application No. 10/018,691 was filed on December 20, 2001, and the associated Transmittal Letter listed the associated Customer Number as "09629". An Address Change Letter was filed with the U.S. PTO on January 1, 2002, changing the address for all of the applications associated with Customer Number 09629 to the 1111 Pennsylvania Avenue, N.W., address. The Response to Notification of Missing Requirements filed on April 18, 2003, listed the 1111 Pennsylvania Avenue, N.W., address. Furthermore, petitioners also filed a Status Inquiry on September 10, 2003, to which they have not received a reply. Thus, The U.S. PTO was given timely and proper notice that petitioner's address had changed about 19 months prior to the mailing date of the Decision. Furthermore, petitioner attempted to check on the status of the application, indicating that they were concerned about its status. In a conversation between the undersigned on January 12, 2004 during which the address problem was discussed, PCT Legal Examiner R. Bacares recommended that petitioner file this Renewed Petition without any EOT fees. For these reasons, petitioners hereby request that this Renewed Petitioner be view as being timely filed within the initial two month time period set by the Decision.

In response to the Decision's requirement to provide proper declarations, please find enclosed properly executed declarations signed by Mr. Smidansky and Mr. Strobel on their behalf and on the behalf of the nonsigning joint inventor David M. Long.

In response to the Decision's requirement that petitioner submit a Sequence Listing, please note that on April 18, 2003, Applicants did timely file a diskette containing the Sequence Listing along with a paper copy and a Statement Accompanying Sequence Listing as required in the Notification of Missing Requirements dated March 20, 2002. A copy of Applicants' date-stamped postcard receipt is attached. Applicants will gladly file a duplicate copy of these sequence-related materials if requested.

As indicated in the Decision, petitioners acknowledge that there is no additional petition fee due with this submission.

Petitioners believe that this Renewed Petition satisfies all of the requirements set forth in the Decision. Applicants respectfully request that the application immediately be processed for examination.

However, except for issue fees payable under 37 C.F.R. §1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §1.16 and §1.17 which may be required, or credit any overpayment to Deposit Account No. 50-0310. Specifically, the Commissioner is authorized to charge a 3 month EOT fee under 37 C.F.R. 1.136(a) if this Renewed Petition is not found to be timely filed despite petitioner's arguments to the contrary, as set forth above.

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Date: January 13, 2004



Erich E. Veitenheimer

Registration No. 40,420

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PATENT

Attorney Docket No.: 057309-5002-US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David M. LONG *et al*

U.S. Application No.: 10/018,691

International filing date: July 2, 1999

For: TAXOL PRODUCTION VIA GENERATION OF
EXTRACHROMOSOMAL DNAs IN THE
FUNGUS *PESTALOTIOPSIS*

Group Art Unit: not assigned

Examiner: not assigned

Attention: International Division, Legal Staff

Box PCT

Commissioner for Patents

Washington, D.C. 20231

Sir:

**STATEMENT OF FACTS IN SUPPORT
OF PETITION UNDER 37 C.F.R. § 1.47(a)**

I, Rebecca W. Mahurin, Ph.D., declare as follows:

1. I reside at 5 West Cleveland St., Bozeman, Montana 59715.
2. I am Director of the Technology Transfer Office at Montana State University.
3. U.S. Patent Application No. 10/018,691 based on PCT/US99/15135, was originally assigned to Research and Development Institute, Inc. at reel 013436 frame 0108.
4. Montana State University maintains that it is assignee to the entire right and title to U.S. Patent Application No. 10/018,691 as the subject matter of this application was developed by employees of Montana State University using the facilities and equipment of Montana State University.
5. David M. Long is an original named inventor of U.S. Patent Application No. 10/018,691 based on PCT/US99/15135.
6. David M. Long was employed by Montana State University beginning in July 1998. David M. Long terminated his employment with Montana State University in December 1999. I believe the current address of David M. Long is 414 S. 8th Street, Livingston, MT 59047.

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Application No. 10/018,291

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7. On October 16, 2002, responsibility for the prosecution of the above captioned patent application was transferred back to Montana State University from Research and Development Institute, Inc. at reel 013444, frame 0805.
8. On November 20, 2002, I telephoned David M. Long and requested that he sign a combined Declaration and Power of Attorney for the above captioned application. Dr. Long said that he would not sign the document. A copy of my notes from this conversation are attached as Exhibit A.
9. On January 8, 2003, I sent David M. Long, via certified mail, a full copy of the above captioned application, including claims, drawings, assignment, combined declaration and power of attorney and a letter requesting signature where required on each document. In this letter I indicated that given David Long's statements in our November 20, 2002, telephone conversation, if we did not receive the documents within two weeks of mailing this will constitute a refusal to sign. A copy of this letter is attached as Exhibit B.
10. On January 18, 2003 David Long received the aforementioned documents as evidenced by a Domestic Return Receipt that he signed. A copy of the Domestic Return Receipt is attached as Exhibit C.
11. As of today, David M. Long has not responded to our request to sign the aforementioned documents.
12. I further declare that all statements made herein of our own knowledge are true, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-referenced patent.

Dated: 3/7/03

By: Rebecca W. Mahurin, PhD
Rebecca W. Mahurin, Ph.D.
Director of Technology Transfer Office,
Montana State University

Phone Call Notes
Long, David
11.20.02

41114-5002-US
10/018, 681
and
47714-5001-US
10/018, 551

I called David Long at home and left a message on his voice mail on the morning of November 20, 2002. (Home number 406-222-9416)

David returned my call less than an hour later and left on my voice mail his work number to call. (Work number 406-222-2986)

I called David back at the work number later in the morning of November 20, 2002. I asked if it was a problem to talk at work and he stated, "No."

I explained that RDI was now dissolved, and that all technology transfer matters were now being handled by my office. He asked why. I explained that it was an efficiency and cost saving move on the part of the University.

I then explained that I was working with the patent attorneys regarding the Telomerase patents. I asked if he would be willing to sign the assignments for the PTO, thus making it easier for us to obtain patents on these technologies. He responded that he would not be willing to sign. He said it was not in his best interests to sign. He said that we could proceed in any way we wanted to, and he would not try to interfere.

He explained that MSU had not been loyal to him and not done anything when he was not hired into a position in the Plant Sciences Department. He said that MSU could have given him lab space and a salary and he would have been happy to continue working at MSU, but that did not happen.

He said he did not harbor any grudges against me and knew that I had always been interested in him and his technology.

I explained that I would be sending him a letter for his signature. I would appreciate it if he would reconsider, but it was his option to either sign or not sign. He also stated that it would not be possible for MSU to patent without his signature. He asked if that was correct. I stated that it was my understanding that we may still be able to patent. He said he didn't see how we could exclude him as an inventor. I explained that he would be included as an inventor. I also stated that if we ever received any remuneration for this technology that we would share with him as though he had been cooperative. He said I should know that this issue was not about money. I told him I knew that, but that MSU would not deprive him of revenues. He said he appreciated that.

This was a friendly conversation. David and I have always had friendly conversations and this was no different.

LDM-1997-PESTAL



OFFICE OF TECHNOLOGY TRANSFER

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P.O. Box 172460
Bozeman, MT 59717-2460
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4714-5001-US
4.114-5002-US
Advanced Technology Park
900 Technology Blvd., Suite A
Bozeman, MT. 59718-6657
Telephone (406) 994-7868
Fax (406) 994-7001
E-mail: technologytransfer@montana.edu

January 7, 2003

David Long, Ph.D.
414 South 8th
Livingston, MT 59047

Dear David:

Thank you for speaking with me on November 20, 2002 regarding the patent applications, "Taxol Production via Generation of Extrachromosomal DNAs in the Fungus Pestalotiopsis" and "In Vivo Addition of Telomeric Repeats to Exogenous DN Generates Extrachromosomal DNAs in the Fungus Pestalotiopsis."

In the November 20th conversation you stated that you would not sign the Assignments and Powers of Attorney for either of the above listed patent applications. I am sending to you the specifications for each of the two application listed above, including claims, drawings, Assignments and Combined Declaration and Powers of Attorney. I have marked each signature requirement with a blue sticky note labeled "sign." I ask that you please promptly sign and return the enclosed documents. Given that you have stated your refusal to sign documents for these two applications during our phone conversation of November 20, if we do not receive the documents from you within the next two weeks, this will constitute a refusal to sign.

I continue to desire to work with you in this matter, David. Please give this request your consideration. Should you have questions regarding this letter or matters related to these patent applications, please call me at 994-2752.

Thank you for your consideration of this request.

Sincerely,

Rebecca W. Mahurin, Ph.D.
Director, Technology Transfer Office

5001-US
-5002-US

SENDER: COMPLETE THIS SECTION

- Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired.
- Print your name and address on the reverse so that we can return the card to you.
- Attach this card to the back of the mailpiece, or on the front if space permits.

1. Article Addressed to:

David Long
414 S. 8th St.
Livingston, MT 59047-3303

COMPLETE THIS SECTION DELIVERY

A. Signature
X *David M. Long* ☐ Agent
☐ Addressee

B. Received by (Printed Name)
David M. Long C. Date of Delivery
7/8-03

D. Is delivery address different from item 1? ☐ Yes
If YES, enter delivery address below: ☒ No

3. Service Type
☒ Certified Mail ☐ Express Mail
☐ Registered ☐ Return Receipt for Merchandise
☐ Insured Mail ☐ C.O.D.

4. Restricted Delivery? (Extra Fee) ☐ Yes

2. ZIP+4 Number
(Transfer from service label)

7002 0510 0003 4589 8422

PS Form 3811, August 2001

Domestic Return Receipt

102595-01-M-0381

UNITED STATES POSTAL SERVICE



First-Class Mail
Postage & Fees Paid
USPS
Permit No. G-10

• Sender: Please print your name, address, and ZIP+4 in this box •

Rebecca W. Mahurin
Montana State University
Technology Transfer Office
900 Technology Blvd., Ste. A
Bozeman, MT 59718-4011

